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CHARLES E. THREEDY, J. H. SUTHERLAND

IN THE
SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1941.

EXHIBIT SUPPLY COMPANY,

Petitioner,

vs.

ACE PATENTS CORPORATION,

Respondent.

No. 154.

GENCO, INC.,

vs.

ACE PATENTS CORPORATION,

Respondent.

No. 155.

CHICAGO COIN MACHINE COMPANY,

Petitioner,

vs.

ACE PATENTS CORPORATION,

Respondent.

No. 156.

REPLY BRIEF FOR PETITIONERS

Re Petition for Writ of Certiorari to the United States
Circuit Court of Appeals for the Seventh Circuit.

CLARENCE E. THREEDY,
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Attorneys for Petitioners.

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REPLY BRIEF FOR PETITIONERS

**Re Petition for Writ of Certiorari to the United States
Circuit Court of Appeals for the Seventh Circuit.**

To the Honorable the Chief Justice of the United States
and the Associate Justices of the Supreme Court of the
United States:

**Respondent's Assertion That This Is an Ordinary Patent
Case Is Contradicted by Its Admission (Brief page 10)
That " 'The Reasons Relied Upon for Allowance of
the Writs' Are Primarily Reasons of Policy, etc.' "**

No ordinary patent case would present a question or rea-
son of policy under the patent laws.

No ordinary patent case would present a question of the propriety of a court-made doctrine, recognized in its inception as contrary to the statutes, and the inconsistent and anomalous character of which has been repeatedly pointed out by the lower courts.

No ordinary patent case would involve a situation where the lower court condones an enlargement of the claimed invention to engulf an intervening device, simply because the intervening device had been mentioned in the transactions with the Patent Office.

In truth, this is an extraordinary patent case.

The Petition Presents No Issue of Fact.

That it is not necessary for this court to consider any issue of fact may be demonstrated by the statement of three succinct points of fact:

1. A point of fact which Respondent concedes (Brief page 3) is that the claim in suit does not read upon the accused devices, Exhibits 8 and 9.
2. A point of fact which was determined by the court below is that the claim in suit does not read literally upon the accused devices, Exhibits 6 and 10. We rest upon the finding of the Circuit Court of Appeals.
3. A point of fact which was determined by the court below and which we do not controvert here is that the claim in suit, when construed by dictionary, does read literally upon the accused devices, Exhibits 5 and 7.

The aforesaid first point of fact provides the factual basis for the first of the "Questions Presented" by the

- **Record page 678.** "With respect to . . . Exhibits 6 and 10, it may be said that . . . appellants have cut a large hole in the pin table at the point where the conductor is normally embedded and have covered this hole with an additional plate of metal which is secured to a pin table by the standard, and they have embedded the conductors in this metal plate."

Petition (Petition page 4). Either the first or the second of the aforesaid points of fact provides the factual basis for the second of the "Questions Presented." The third of the aforesaid points of fact provides the factual basis for the third of the "Questions Presented."

The Patent in Suit Represents a Case of Broadening an Application After Adverse Rights of the Public Had Intervened.

It is undisputed that the claims of the patent application, as filed, failed to comprehend any of Petitioners' accused devices. It is undisputed that, after Respondent knew of Petitioners' device (Exhibit 5, Exhibit 23, R. 357), Respondent broadened its claim for the ostensible purpose (R. 450-1) of ensnaring Petitioners' device.

If Respondent had amended its specification to say what was said informally in the "Remarks" of an amendment, there could be no dispute about the applicability of the doctrine of *Schriber-Schroth v. Cleveland Trust Co. et al.*, 305 U. S. 47. The question is, therefore, whether intervening rights of the public can be rendered nugatory by doing informally what could not be done formally.

The File Wrapper Estoppel Defense Is Not Urged With Reference to Exhibits 5 and 7 Upon Which the Court Below Held the Claim Readable.

Respondent says:

"The only significant alteration in the claim is that in which the term 'carried by' was altered to 'embedded in' the table" (Respondent's Brief, page 6).

That is the alteration which we insist estops Respondent from contending that a device whose conductor is not embedded in the table, is an infringement.

The Enlargement of a Patent Monopoly Beyond the Plain Terms of the Claim Is the Only Aspect of the Doctrine of Mechanical Equivalents Which Petitioners Seek to Have Clarified or Abolished.

The first question presented by the Petition reads as follows:

“1. Is the scope of a patent limited by its claims or may it be enlarged therebeyond by the so-called doctrine of mechanical equivalents?”

The question presented is not affected by any precedent or host of precedents where the claim in suit actually read upon the accused device, as in:

Smith v. Snow, 294 U. S. 1;

Sanitary Refrigerator Co. v. Winters, 280 U. S. 30;

Eibel Process Co. v. Minnesota & Ontario Paper Co.,
261 U. S. 45;

Hildreth v. Mastoras, 257 U. S. 27;

Abercrombie & Fitch Co. v. Baldwin, 245 U. S. 198;

Continental Paper Bag Co. v. Eastern Paper Bag
Co., 210 U. S. 405;

Hobbs v. Beach, 180 U. S. 383;

Deering v. Winona Harvester Works, 155 U. S. 286;

all cited by Respondent, Brief pages 10-11.

On the contrary, the question presented involves the correctness of the doctrine of *Winans v. Denmead*, 56 U. S. 330; *Ives v. Hamilton*, 92 U. S. 426, and *Hoyt v. Horne*, 145 U. S. 302. As pointed out in the Petition, this court recognized at the time of its decision in *Winans v. Denmead* that the doctrine then adopted by it was inconsistent with the dictates of the statute.

Long prior to *Winans v. Denmead*, this court had ruled that an accused device was not an infringement of a patent, notwithstanding that it came within the claim, if it was not an equivalent (*McCormick v. Talcott*, 20 Howard 402; *Burr v. Duryee*, 1 Wallace 531). Petitioners here do not question the propriety of the rule that an accused

device which is not the equivalent of that disclosed in the patent is not an infringement, the words of the claim to the contrary notwithstanding. However, Petitioners contend that an accused device is not an infringement of a patent, albeit an equivalent to the device disclosed therein, if it does not respond to the plain terms of the claim.

Petitioners contend that, to establish infringement as a matter of law, an accused device must:

1. Respond to the plain terms of the claim, and
2. Be an equivalent of that which is disclosed in the patent.

Either without the other is insufficient to establish infringement. Conceding, for the sake of argument, that the devices here accused are used to produce the same effect as the device disclosed in the patent, the charge of infringement must fail because the devices (Exhibits 6, 8, 9 and 10) do not respond to the plain terms of Respondent's claim.

Conclusion.

We repeat that it is safe to say that patent litigation would be markedly reduced if the doctrine of mechanical equivalents were either clarified or abolished. To respondent's repartee that "all litigation would be markedly reduced if all legal doctrines were either clarified or abolished," we suggest that, in the march of jurisprudence toward the goal of perfection (simplicity), this Court has contributed greatly to the reduction of all litigation by just such clarification and abolition of anomalous legal doctrines, as we pray the Court to review in this case.

Respectfully submitted,

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Attorneys for Petitioners.

September 13, 1941.